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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/503,421 02/14/00 SCHWAEBLE

W 3523 P 004

EXAMINER
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HM22/0425

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ART UNIT	PAPER NUMBER
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ROMEO, D

1647

DATE MAILED:

04/25/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/503,421

Applicant(s)  
Schwaeble

Examiner  
David Romeo

Group-Art Unit  
1647



☒ Responsive to communication(s) filed on 14 Feb 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-10 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-10 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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**DETAILED ACTION*****Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-3, 9, to the extent that they are drawn to a cC1qR binding domain,  
5 classified in class 530, subclass 350.

II. Claims 4-9, to the extent that they are drawn to an indeterminate inhibitor of a  
cC1qR binding domain, indeterminate class, indeterminate subclass.

III. Claim 10, to the extent that it is drawn to a method of treatment using a cC1qR  
binding domain, classified in class 514, subclass 12.

10 IV. Claim 10, to the extent that it is drawn to method of treatment using an  
indeterminate inhibitor of a cC1qR binding domain, indeterminate class,  
indeterminate subclass.

2. The inventions are distinct, each from the other because of the following reasons:

The following pairwise combinations of products are independent and distinct, wherein  
15 neither member of a pair is required for the production or use of the other, and wherein each of  
the pair can be manufactured independently of the other and used for independent and distinct  
purposes: I and II.

Inventions I and III are related as product and process of use. The inventions can be  
shown to be distinct if either or both of the following can be shown: (1) the process for using the

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product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP

§ 806.05(h)). In the instant case I could be used as an antigen in its own right, or in assays for the determination of agonists and antagonists thereto.

- 5           The following pairwise combinations of products and methods are independent and distinct, wherein the respective products may neither be produced by, nor used in the respective methods: I and IV; II and III.

          Inventions II and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the  
10   product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP  
§ 806.05(h)). In the instant case II could be used as an antigen in its own right, or in assays for the determination of agonists and antagonists thereto.

3.       Because these inventions are distinct for the reasons given above and have acquired a  
15   separate status in the art as shown by their different and/or indeterminate classification, restriction for examination purposes as indicated is proper.

4.       Because these inventions are distinct for the reasons given above and the searches required are not coextensive, restriction for examination purposes as indicated is proper.

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5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. This application contains claims directed to the following patentably distinct species of the claimed invention: the species listed in claim 6, 7, 8.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-10 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

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examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

7. This application contains claims directed to the following patentably distinct species of the claimed invention: SEQ ID NO: 1, 2, or 3.

5 Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-10 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon,  
10 including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election,  
15 applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

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examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

*Response to Preliminary Amendment*

9. The preliminary amendment to the specification filed concurrently with the instant application has been entered.

10. The preliminary amendment to the claims filed concurrently with the instant application has not been entered, because the amendment requests the addition of more than five words in at least one claim. See 37 CFR 1.121(a)(2)(i) below:

(i) Instructions for insertions and deletions: A claim may be amended by specifying only the exact matter to be deleted or inserted by an amendment and the precise point where the deletion or insertion is to be made, where the changes are limited to:

(A) Deletions and/or

(B) The addition of no more than five (5) words in any one claim; or

The interlineations or cancellations made in the amendments to the claims could lead to confusion and mistake during the issue and printing processes. The number or nature of the claim

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amendments renders it difficult to consider the application. Accordingly, the claims are required to be rewritten before examination. See 37 CFR 1.125 and MPEP § 608.01(q).

**ALL AMENDMENTS FILED MARCH 1, 2001 (OR LATER) MUST COMPLY  
WITH REVISED 37 CFR 1.121.**

5 Applicants should refer to the rule package published in the Federal Register on September 8, 2000, 65 Fed. Reg. 54603 (September 8, 2000), and the Official Gazette on September 19, 2000, 1238 Off. Gaz. Pat. Office 77 (September 19, 2000) for changes in the manner and process of making amendments.

10 ANY INQUIRY CONCERNING THIS COMMUNICATION OR EARLIER COMMUNICATIONS FROM THE EXAMINER SHOULD BE DIRECTED TO DAVID S. ROMEO WHOSE TELEPHONE NUMBER IS (703) 305-4050. THE EXAMINER CAN NORMALLY BE REACHED ON MONDAY THROUGH FRIDAY FROM 6:45 A.M. TO 3:15 P.M.

IF ATTEMPTS TO REACH THE EXAMINER BY TELEPHONE ARE UNSUCCESSFUL, THE EXAMINER'S SUPERVISOR, GARY KUNZ, CAN BE REACHED ON (703) 308-4623.

15 OFFICIAL PAPERS FILED BY FAX SHOULD BE DIRECTED TO (703) 308-4242.

FAXED DRAFT OR INFORMAL COMMUNICATIONS SHOULD BE DIRECTED TO THE EXAMINER AT (703) 308-0294.

ANY INQUIRY OF A GENERAL NATURE OR RELATING TO THE STATUS OF THIS APPLICATION OR PROCEEDING SHOULD BE DIRECTED TO THE GROUP RECEPTIONIST WHOSE TELEPHONE NUMBER IS (703) 308-0196.

20   
DAVID ROMEO  
PRIMARY EXAMINER  
ART UNIT 1647

APRIL 24, 2001